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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,631	04/02/2004	Robert Poth	MMIC1100-1	2851
38396	7590	05/12/2005	EXAMINER	
JOHN BRUCKNER, P.C. 5708 BACK BAY LANE AUSTIN, TX 78739			MASINICK, MICHAEL D	
			ART UNIT	PAPER NUMBER
			2125	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/817,631

Applicant(s)

POTH, ROBERT

Examiner

Michael D. Masinick

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Response to Amendment***

Applicant's amendments and arguments have been reviewed and are found to be non-persuasive. All USC 112 issues have been addressed and those rejections are removed. All art rejections stand as previously written with additional citations for the amendments set forth by applicant.

Applicant asserts that the Berstis reference does not show newly amended claim element "recording and accruing system usage data in the on board memory of the programmable digital thermostat according to each of the plurality of system users' personal identification numbers." Examiner disagrees with this assessment based, among other places, Column 8, lines 28-64 of Berstis which recites multiple logging systems and tracking databases for keeping records of the various "conditions in which the vehicle was driven". Looking at Figures 14-20 of Berstis shows the onboard database structure used to manage the vehicle (See figure 18 for "temperature adjustments"). Berstis is clearly able to store all of this data in the logs as required by the person designing the system.

1. While it could be argued that the Berstis reference is not a "usage monitoring heating ventilation and air conditioning system", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is **capable of performing the intended use**, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

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See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

2. In this case, Berstis shows the ability to provide all functions of the current invention and thus meets the claim.

3. It is further noted that claim 3 still contains the word "can" which effectively makes it non restrictive since none of the recited elements would be required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,198,996 to Berstis.

3. Referring to claim 1, Berstis shows a method comprising: providing a usage monitoring heating ventilation and air conditioning control system, the usage monitoring heating ventilation control system including a programmable digital thermostat with an onboard memory ("onboard computer"/ RAM/ROM. Figure 4 – "comfort system", Col 1, lines 55-57); issuing personal identification numbers to a plurality of system users (Column 15, lines 33-49); associating each of the plurality of system users with at least one of a plurality of user types (Col 4, lines 24-30);

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storing the personal identification numbers in a first data structure in the on board memory; linking each one of a plurality of entries in the first data structure by reference to at least one of a pluralities of entries in a second data structure in the on board memory, the second data structure including a list of user types; and recording and accruing system usage data in the on board memory of the programmable digital thermostat according to each of the plurality of system users' personal identification numbers (Col 8, lines 27-64). See Figures 14-20 of Berstis for a simple database structure which shows these database related elements. Examiner points also to claim 1 of Berstis for a very similar claim structure to the current claim.

4. Referring to claim 2, Berstis shows wherein each of the plurality of user types is associated with at least one of a plurality of function sets (Figure 18).

5. Referring to claim 3, Berstis shows wherein the on board memory is one of a variety of memory choices (Column 3, lines 5-Col 4, line 8).

6. Referring to claim 4, Berstis shows dynamically updating the first and second data structures (Column 4, line 64 – Col 5, line 5).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,198,996 to Berstis.

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9. With respect to what has been shown above in relation to claims 1-4, Berstis does not specifically show that each user is associated with a user type selected from the group consisting of building owners, maintenance personnel, building tenants, and manufacturers.

10. Berstis does show the ability to have different user groups and different security levels for the different user groups as shown above (Column 4, lines 24-30 specifically). It would have been obvious to one of ordinary skill in the art at the time the invention was made to create user groups based upon the desired security levels of the personnel who would be using the system and where the system was to be used because those users would require a different security setting depending on the job and other reliability factors.

11. Referring to claim 29, Berstis shows where each user's PIN number (password) belongs to one user group (Column 4, lines 24-30 specifically).

12. Referring to claim 30, Berstis shows wherein access to the interactive user interface of the programmable thermostat is regulated using at least one of a plurality of software filters (Column 4, lines 34-47).

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and to the state of the art at the time of invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D Masinick whose telephone number is (571) 272-3746. The examiner can normally be reached on Mon-Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MDM



LEO PICARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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